

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

<p>PATENT NO.: 7,570,742</p> <p>FIRST NAMED INVENTOR: Steven A. Johnson</p> <p>SERIAL NO.: 10/615,569</p> <p>FILED: 7/7/2003</p> <p>FOR: APPARATUS AND METHOD FOR IMAGING OBJECTS WITH WAVEFIELDS</p> <p>DOCKET NO.: 01682-22027.CIP3.CON2</p>	<p><u>CERTIFICATE OF MAILING</u> <u>UNDER 37 C.F.R. § 1.8</u></p> <p>DATE OF DEPOSIT: <u>May 14, 2010</u></p> <p>I hereby certify that this paper or fee (along with any paper or fee referred to as being attached or enclosed) is being submitted on the date indicated above via:</p> <p><input checked="" type="checkbox"/> EFS Web</p> <p><input type="checkbox"/> facsimile to _____</p> <p><input type="checkbox"/> the United States Postal Service with sufficient postage as first class mail addressed to: Mail Stop _____ Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p>_____ /Garron M. Hobson/ Garron M. Hobson</p>
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THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219

Petition under 37 C.F.R. § 1.182 and MPEP 1490(VII)(B) for withdrawal of incorrect terminal disclaimer and replacement with corrected terminal disclaimer

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Petitioner respectfully petitions under 37 C.F.R. § 1.182 and MPEP 1490(VII)(B) for withdrawal of incorrect terminal disclaimer and replacement with corrected terminal disclaimer.

REMARKS

Petitioner respectfully petitions under 37 C.F.R. § 1.182 and MPEP 1490(VII)(B) for withdrawal of incorrect terminal disclaimer and replacement with corrected terminal disclaimer. Specifically, Petitioner requests withdrawal of incorrect terminal disclaimer incorrectly identifying Patent No. 6,587,590, and replacement with corrected terminal disclaimer correctly identifying Patent No. 6,587,540.

Submitted herewith is:

- 1) A petition under 37 C.F.R. § 1.182 and pursuant to MPEP 1490(VII)(B) to withdraw an incorrect terminal disclaimer (incorrectly identifying Patent No. 6,587,590) and replace it with a correct terminal disclaimer (correctly identifying Patent No. 6,587,540).
- 2) The petition fee of \$400.00 pursuant to 37 C.F.R. § 1.17(f).
- 3) A corrected terminal disclaimer correctly identifying Patent No. 6,587,540.

Petitioner submits that the identification of Patent No. 6,587,590 in the terminal disclaimer was inadvertent (as opposed to correctly identifying Patent No. 6,587,540) and that such inadvertency is clear from the record.

The subject Patent No. 7,570,742 claims priority to Patent Nos. 6,636,584 and 6,587,540. The subject Patent 7,570,742 and Patent Nos. 6,636,584 and 6,587,540 are assigned to Techniscan, Inc. of Salt Lake City, Utah, and name common inventors, namely Steven A. Johnson, David T. Borup, James Wiskin and Michael J. Berggren.

During prosecution of the subject Patent No. 7,570,742, the claims were rejected on the ground of nonstatutory obviousness-type double patenting in view of Patent Nos. 6,636,584 and 6,587,590. See Office Action dated October 11, 2006; page 3. Applicant submitted a response including a terminal disclaimer identifying Patent No. 6,587,590. See response and terminal disclaimer submitted January 9, 2007.

The incorrect Patent No. 6,587,590 was assigned to The Trustees of the University of Pennsylvania, and named as an inventor Feng Pan.

The identification of incorrect Patent No. 6,587,590 in the Office Action and the incorrect terminal disclaimer was obviously an inadvertent error intended to identify correct Patent No. 6,587,540 because:

- 1) subject Patent No. 7,570,742 claims priority to correct Patent No. 6,587,540, but does not claim priority to incorrect Patent No. 6,587,590;
- 2) subject Patent No. 7,570,742 has a common assignee with correct Patent No. 6,587,540 (namely Techniscan, Inc. of Salt Lake City, Utah), but does not have a common assignee with incorrect Patent No. 6,587,590 (The Trustees of the University of Pennsylvania); and
- 3) subject Patent No. 7,570,742 has common inventors with correct Patent No. 6,587,540 (namely Steven A. Johnson, David T. Borup, James Wiskin and Michael J. Berggren), but does not have common inventors with incorrect Patent No. 6,587,590 (Feng Pan).

Therefore, Petitioner submits that the identification of Patent No. 6,587,590 in the terminal disclaimer was inadvertent (as opposed to correctly identifying Patent No. 6,587,540) and that such inadvertency is clear from the record.

In addition, in Applicant's continuation Application Serial No. 11/436,989 (which is a continuation of subject Patent No. 7,570,742 and also claims priority to Patent Nos. 6,636,584 and 6,587,540), the claims were again rejected on the ground of nonstatutory obviousness-type double patenting in view of Patent Nos. 6,636,584 and 6,587,590. See Office Action dated May 27, 2009; page 2. Applicant noted the incorrect patent number in the Office Action and informed the Examiner of the discrepancy. See response dated August 26, 2009, page 9. Applicant further notes that the examiner was the same in both cases. Applicant submitted a terminal disclaimer correctly identifying Patent No. 6,587,540, and such terminal disclaimer with the correct Patent No. 6,587,540 was accepted.

Furthermore, in Applicant's continuation Application Serial No. 11/223,084 (which is a continuation of subject Patent No. 7,570,742 and also claims priority to Patent Nos. 6,636,584 and 6,587,540), the claims were again rejected on the ground of nonstatutory obviousness-type double patenting in view of Patent Nos. 6,636,584 and 6,587,540. Applicant notes that this time the correct patent number was identified.

Therefore, Petitioner submits that the identification of Patent No. 6,587,590 in the terminal disclaimer was inadvertent (as opposed to correctly identifying Patent No. 6,587,540) and that such inadvertency is clear from the record.

Petitioner requests withdrawal of incorrect terminal disclaimer incorrectly identifying Patent No. 6,587,590, and replacement with corrected terminal disclaimer correctly identifying Patent No. 6,587,540.

MPEP 1490(VII)(B) states that if the error resulted in an earlier patent term expiration date than provided by the corrected terminal disclaims, as statement must be included in the corrected terminal disclaimer to retain that earlier expiration date. It appears that the correct Patent No. 6,587,540 expires October 14, 2012, while incorrect Patent No. 6,587,590 expires February 2, 2019. Therefore, no statement to retain the earlier expiration date is required because the expiration date of the incorrect Patent No. 6,587,590 is not earlier.

CONCLUSION

If any impediment to the grant of this petition remains, the Examiner is strongly encouraged to call Garron M. Hobson at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Petition to Deposit Account No. 20-0100.

DATED this 14th day of May, 2010.

Respectfully submitted,

/Garron M. Hobson/
Garron M. Hobson
Registration No. 41073

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone: (801) 566-6633

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